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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/531,102

Filing Date: March 17, 2000

Appellant(s): GIANNINI ET AL.

Mr. Robert J. Crawford
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

The following application was returned by the Board of Patent Appeals and Interferences on 17 October 2008. It was ordered returned for the Examiner to (1) vacate the Examiner's Answer mailed 08 March 2007; (2) to generate a new Examiner's Answer which does not refer directly or indirectly to a prior Office action without fully restating the point relied on in the answer; and (3) any further such action that is required. This is in response to the appeal brief filed 14 November 2006 appealing from the Office action mailed 23 June 2006.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,016,504	ARNOLD et al	1-2000
5,537,211	DIAL	7-1996
6,323,969	SHIMIZU	3-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

Claims 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Use of the word “compatible” makes the Claim vague and indefinite. One persons color compatibility could be unpleasant to another person; no consistent, objective standard of color compatibility is set out.

Consider clothing colors of the 1970s. Bright orange and green colors were considered “compatible” by some, but not others at the time, and the combination is now generally considered ugly.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 19-22 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,016,504 *Arnold et al*, already of record, in view of US 5,537,211 *Dial*.

As to Claim 17, *Arnold* discloses the invention substantially as claimed, including in a system for comparison of multiple apparel articles, elements of:

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an on-line viewer site (Fig. 1B, ele. 1B12, 1B13 and 1B14); and
a computer-driven web-linking engine (Col. 8, line 8 to Col. 11, line 33) configured and arranged to display a first colored apparel article selected by an on-line viewer from the on-line viewer site (Fig. 1B, ele. 1B13, Shirt) for display with a second colored apparel article selected by an on-line viewer from the on-line viewer site (Fig. 1B, ele. 1B14, Pants).

Arnold does not specifically disclose using a color matching criterion to determine whether the first colored apparel article color matches the second colored apparel article color. *Dial* discloses this limitation at Col. 6, lines 35-48. In this instance, a first colored apparel article (e.g., belt) is color matched to a second colored apparel article (e.g., a dress). It would have been obvious to one of ordinary skill in that art at the time of the invention to include the color matching feature of *Dial* in the apparel article comparison system of *Arnold* because this would provide a smallest difference between the colors of the two apparel articles. This motivation is specifically set out by *Dial* at Col. 6, lines 49-61, and repeated below:

The metric used by the present invention to determine an appropriate wearable measures the difference in color between an object of interest and a wearable in a database. Small values of the metric indicate a close color match whereas large values indicate a poor match. The metric characterizes the color distance from an object of interest to each available wearable. As described above, the object may be skin and the wearable a cosmetic, or the object may be an article of clothing and the wearable another article of clothing. In general, the object may any object whose color is measured and the wearable any of a selection from which to find the best color match. The best match wearable is the selection characterized by the smallest value of the metric.

Concerning Claim 19, *Arnold* discloses a first colored apparel article retrieved from a first store (Fig. 1B, ele. 1B20, Haberdasher Co.) and a second colored apparel article retrieved from a second store (Fig. 1B, ele. 1B30, Mad Hatter Co.)

Concerning Claim 20, *Arnold* discloses a first colored apparel article retrieved from a first store (Fig. 1B, ele. 1B20, Haberdasher Co., Pants) and a second colored apparel article retrieved from the same store (Fig. 1B, ele. 1B20, Haberdasher Co., Shirt)

With respect to Claim 21, *Arnold* discloses that at least one of the first and second colored apparel articles is provided by a retail store (Fig. 1B, ele. 1B20, Haberdasher Co., Pants) and that the web-linking engine is independent of the retail store (Fig. 1B, ele. 1B10, ACME Cyberstore).

Regarding Claim 22, see the discussion of Claims 19 and 21.

Regarding Claim 30, *Dial* discloses a color reference-coding chart at Col. 7, line 42 to Col. 8, line 32, particularly Table II.

With Respect to Claim 31, *Dial* discloses color-coding based on measured color frequencies (wavelength) at Col. 8, lines 36-45.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,016,504 *Arnold et al*, already of record, in view of US 5,537,211 *Dial* and further in view of US 5,930,769 *Rose*, already of record.

With respect to Claim 18, *Arnold* discloses the invention substantially as claimed. See the discussion of Claim 17. *Arnold* does not disclose an image corresponding to a structure dressed in apparel articles. *Rose* discloses this limitation at Col. 7, lines 44-67, particularly lines 58-62. It would have been obvious to one of ordinary skill in that art at the time of the invention to modify *Arnold* to include the image corresponding to a structure dressed in apparel articles

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(mannequin) of *Rose* because this would show a customer how selected apparel articles would fit and look. See *Rose* at Col. 7, lines 8-62 for this motivation.

Claims 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,016,504 *Arnold et al*, already of record, in view of US 5,537,211 *Dial* and further in view of US 6,323,969 *Shimizu et al*.

As to Claim 23, *Arnold* discloses the invention substantially as claimed. See the discussion of Claim 17. *Arnold* does not specifically disclose comparison of color codes. *Shimizu* discloses such codes at Fig. 39 and Background of the Invention. See CMY values 255 255 255, fifth and seventh entries, right hand column of Fig. 39. Note that these “match” having the same values. Additionally, see Fig. 37, which indicate color matches as “In Color Range”. It would have been obvious to one of ordinary skill in that art at the time of the invention to modify *Arnold* to use the color codes of *Shimizu* as a basis of color comparison of apparel items because this would provide an accurate and objective basis for matching of apparel color and prove esthetically pleasing.

With Respect to Claim 24, note that a color code common to each color for comparison has a common color code (e.g., 255 240 253 and 255 240 247, the string 255 240 being common to each of the color codes).

Regarding Claims 25 and 26, for purpose of examination, the term “compatible” is understood to comprise the concept of identical. See *Shimizu*, Fig. 39 and Background of the Invention. See CMY values 255 255 255, fifth and seventh entries, right hand column of Fig. 39.

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Automatic indication of acceptability would have been obvious to conveniently and quickly let users know of a color match.

With Respect to Claim 27, the CMY color values are implemented in electronic “tag” form, database table entries, as disclosed at Background of the Invention.

Regarding Claim 28, Official Notice is taken that it was old and well known at the time of the invention to encode color information in electronic tags, such as a SKU. It would have been obvious to one of ordinary skill in that art at the time of the invention to modify *Arnold* to include such information to provide color information of products, usable for search and comparison.

With Respect to Claim 29, *Arnold* discloses a virtual closet at Fig. 1B and Col. 7, line 30 to Col. 8, line 44.

Response to Arguments

Applicant's arguments filed April 7, 2006 have been fully considered but they are not persuasive.

Applicants begin argument at page 5, fourth para. of Remarks. Applicants' first argument is that the references teach away from each other because they are not physically combinable. First, Applicants' cite no particular passage in either *Arnold* or *Dial* that specifically states such a teaching away. Second, Applicants argument consists of citing differences between the references, rather than incompatibilities.

In response to this argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor

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is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, the Examiner cited *Arnold* for the larger portion of the claimed invention and *Dial* to disclose the concept of color matching for esthetic purposes. The Examiner did not suggest the bodily incorporation of the physical device of *Dial* in the web shopping of *Arnold*, but rather simple color matching.

At page 6 of Remarks, first full para. Applicants argue that there is no motivation to combine. Applicant only vaguely addresses the Examiners motivation *and citation* to *Dial*, so the argument fails on this basis alone. Applicant fails to note that *Arnold* discloses objects displayed having a “smallest difference” in color, as set out in the rejection of claim 17. The Shirt and Pants displayed at Fig. 1B would provide a basis for comparison of color.

At page 6, second full para., Applicants essentially restate the first two arguments, addressed above. Applicants assert that the modification of *Arnold* by *Dial* would “undermine” the virtual nature of *Arnold*, but provide no reasoning as to why this is so. Applicants fail to explain why a skilled artisan would not be led to combine the references and does not address the motivation set out by the Examiner restated here:

It would have been obvious to one of ordinary skill in that art at the time of the invention to include the color matching feature of *Dial* in the apparel article comparison system of *Arnold* because this would provide a smallest difference between the colors of the two apparel articles. This motivation is specifically set out by *Dial* at Col. 6, lines 49-61, and repeated below:

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The metric used by the present invention to determine an appropriate wearable measures the difference in color between an object of interest and a wearable in a database. Small values of the metric indicate a close color match whereas large values indicate a poor match. The metric characterizes the color distance from an object of interest to each available wearable. As described above, the object may be skin and the wearable a cosmetic, or the object may be an article of clothing and the wearable another article of clothing. In general, the object may any object whose color is measured and the wearable any of a selection from which to find the best color match. The best match wearable is the selection characterized by the smallest value of the metric.

Applicants' last argument at page 6, last para. to page 7, is a variation on the bodily incorporation argument addressed above; the Examiner's response is similar.

The rejections are maintained.

(10) Response to Argument

The Examiner summarizes the various points raised by the Appellant and addresses them individually.

A. Rejection of claims 17-31 under 35 U.S.C. § 103(a) over Arnold in view of Dial.

1. Regarding claim 17 Appellant asserts that there is no motivation to combine the teachings of Arnold with the teachings of Dial and that the references teach away from the combination since Arnold uses web-linking and Dial does not teach any networking when matching colors of clothing (see Appeal Brief, pages 4-6).

In Response: The Examiner respectfully disagrees that there is insufficient motivation to combine the teachings of Arnold with the teachings of Dial. Arnold teaches a method for tracking transactions from a virtual outlet Web site to a merchant Web site on the Internet (column 5, lines 23-26). Arnold teaches an on-line viewer site (column 5, lines 27-40) and a computer driven web-linking engine configured and arranged to display a first colored apparel

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article selected by an on-line viewer site for display with a second colored apparel article selected by an on-line viewer from the on-line viewer site (column 7, line 30 thru column 8, line 6 and Figure 1B, 1B20; Examiner notes that the product information for the articles of clothing contain a color description of each item). This information assists a purchaser in obtaining the necessary product information when determining whether to purchase the articles of clothing.

Arnold does provide some color matching in that the items listed (Figure 1B, 1B20) list the colors of each item. Therefore a user would be able to compare the black or white pants to the green shirt (Figure 1B). Claim 1 fails to elaborate on the “color matching criterion” and simply listing the color of each item would be sufficient to teach a “color matching criterion” when given its broadest reasonable interpretation. Nonetheless, the Examiner has also provided the teachings of Dial to show the teaching of matching articles of clothing based on a color criterion. Dial teaches a method and apparatus for selecting a wearable in which the wearables being matched can be two articles of clothing (column 6, lines 49-61). Dial teaches that the system is computer driven, the computer comprising inputs/outputs, hardware and software (column 5, lines 28-61). Dial teaches a color sensor apparatus connected to a computer (control logic) for reading the colors of the wearables in a store and determining if they are within a certain measurement of one another (column 6, lines 18-48). This allows the purchaser to obtain necessary color information and to determine whether to purchase the wearables.

There is sufficient motivation to combine the computer-driven web linking clothing search and display teachings of Arnold with the computer-driven color matching of wearables (clothing) as taught by Dial because it further assists the purchaser with the decision of whether or not to purchase products by supplying the purchaser with more complete product information.

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Therefore combining the teachings of Arnold and Dial would not frustrate one another. Dial teaches an object of the invention is that it can be used at a point of sale device so that shoppers can make an educated decision on a potential purchase (column 3, lines 27-44). Simply because Dial does not utilize web linking does not mean that the combination of their teachings would be frustrated and neither the teachings of Arnold or Dial would be undermined. Both Arnold and Dial teach the use of computers in providing purchasers with product information before they make purchases and therefore there would be sufficient motivation to combine their teachings as discussed above.

For these reasons, there is sufficient motivations to combine the teachings of Arnold with the teachings of Dial and the combination would not frustrate the teachings of either. Their teachings provide for the matching of clothing items so that a potential purchaser obtains a level of product information capable of assisting the potential purchaser with the decision of whether or not to purchase the products.

B. Rejection of claims 25 and 26 under 35 U.S.C. § 112, second paragraph.

2. Regarding claims 25 and 26 Appellant asserts that the phrase “color compatible” does not render claims 25 and 26 indefinite under 35 U.S.C. § 112, second paragraph because Appellant’s specification teaches that “color compatible” is implemented using objective standards and thus has a meaning discernable to one of ordinary skill in the art (see Appeal Brief, pages 6-7).

In Response: The Examiner respectfully disagrees with the Appellant that one of ordinary skill in the art would be able to discern what is intended by the language of color compatible. The phrase “color compatible” could be both an objective test as set forth by the Appellant, but it

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could also be a subjective test, as set forth by the Examiner. The use of a subjective term renders a claim indefinite because it is not clear to one of ordinary skill in the art what the Appellant regards as the invention. See *In re Moore* 169 USPQ 236. Neither of the claims from which 25 and 26 depend (claims 17 and 23) clarify that “color compatible” would be an objective standard. On the contrary, it appears to be a subjective standard, which utilizes a color code that is provided for each article of clothing for use in the matching criterion (claim 23). This color code could be no more than the actual listing of the color and therefore it would be a subjective test to determine if the color code orange is considered “color compatible” with the color code green.

Therefore, given the broadest reasonable interpretation of the claims, it would not be obvious to one of ordinary skill in the art at the time of the Appellant’s invention what is intended from the phrase “color compatible.” For these reasons claims 25 and 26 are indefinite for failing to particularly point out what the Appellant regards as the invention.

C. Rejection of claims 23-29 under 35 U.S.C. 103(a) over Arnold in view of Dial in further view of Shimizu.

3. Regarding claims 23-29 Appellant asserts that there is no motivation to combine the teachings of Arnold in view of Dial with the teachings of Shimizu (see Appeal Brief, pages 7-8).

In Response: The Examiner respectfully disagrees that there is no motivation to combine the teachings of Arnold in view of Dial with the teachings of Shimizu. Appellant states that the Examiner failed to provide any evidence of motivation to combine the cited references.

However, in the final rejection, the Examiner articulated that the motivation to combine the references was to “provide an accurate and objective basis for matching of apparel color and prove esthetically pleasing.” Therefore Appellant’s argument is without merit. Nonetheless, in

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order to clarify the motivation to combine the teachings of Arnold and Dial with Shimizu the Examiner will further elaborate. Arnold teaches a computer driven web-linking site that displays two colored apparel items as discussed above. Dial teaches a computer driven process for measuring the color of two wearables to determine if they are within an acceptable color range of one another as discussed above. Shimizu further elaborates on making the color matching criteria by teaching an objective manner for representing colors accurately from input devices (column 5, lines 45-67). Shimizu teaches that there are multiple objective ways to measure and represent colors, all of which are old and well known in the art, including CMY signals, RGB signals and L*a*b signals (column 1, lines 31-59). These codes (CMY, RGB and L*a*b*) provide a code for comparing and converting colors as discussed in the claimed invention. There is sufficient motivation to combine the teachings of Arnold and Dial with the teachings of Shimizu because it provides for the accurate and objective basis for matching apparel based on color as mentioned above.

Appellant has not pointed out any specific claims from claims 23-29 or any specific claim language in alleging that Arnold in view of Dial in view of Shimizu fails to teach the claimed limitations. Therefore this argument is not persuasive. For these reasons, there is sufficient motivation to combine the teachings of Arnold in view of Dial in further view of Shimizu and thus claims 23-29 are rejected under 35 U.S.C. 103(a).

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Stefanos Karmis/
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29 October 2008

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